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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,305	11/06/2001	Alexander Winker	81779	9832

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KRIEGSMAN & KRIEGSMAN
665 FRANKLIN STREET
FRAMINGHAM, MA 01702

EXAMINER

SCHIFFMAN, JORI

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,305

Applicant(s)

WINKER, ALEXANDER *ES*

Examiner

Jori R. Schiffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 15-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14, drawn to a nut, classified in class 411, subclass 533.
 - II. Claims 15-22, drawn to method of making a nut, classified in class 29, subclass 509.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the nut and turning plate could be formed on the nut.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Ed Kriegsman on May 2, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the bevel or chamfer on the turning plate must be shown or the feature canceled from the claim. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities: The specification cannot refer to the claims, as in page 1, lines 1 and 2, for example. Appropriate correction is required.

Claim Objections

7. Claims 6 and 7 are objected to because of the following informalities: Claims 6 and 7 recite the limitation "the conical surface" in line 2 of each of the claims. There is insufficient antecedent basis for this limitation in the claims. It appears that they should be dependent upon claim 4 instead of 3. Also, claim 7 recites the phrase "and/or" which is indefinite because it is unclear if the notch is formed by pressing in the conical surface and the neckpiece or the conical surface or the neckpiece. Appropriate correction is required.

8. Claims 8, 9, and 10 are objected to because of the following informalities: Claims 8, 9, and 10 recite the limitation "its inner surface" in line 3 of claim 8 and line 2 of claims 9 and 10.

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There is insufficient antecedent basis for this limitation in the claims. It appears the phrase should read --an inner surface--. Appropriate correction is required.

9. Claim 10 is objected to because of the following informalities: Claim 11 recites the limitation "the cylindrical surface region" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim. It appears the phrase should read --a cylindrical surface region --. Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. As to claim 11, it is unclear what the "bevel or chamfer" is since only a chamfer on the nut, not the turning plate, is shown in the drawings. Appropriate correction is required. The claims have been examined as best understood.

13. Regarding claim 12, the phrase "somewhat trapezoidal" is indefinite because it is unclear if the turning plate is trapezoidal or not. Appropriate correction is required. The claims have been examined as best understood.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Capuano (US 4431353).

Regarding claim 1, Capuano discloses a nut 50 with a nut body 56 with an enlarged shoulder 124 and a turning plate 52 that can rotate (col. 4, l. 32-35) and is inseparably arranged on the nut body, wherein the turning plate is capable of being shoved onto the nut body and secured by means of a locking element which is a bead 100 provided on the nut body, so the turning plate is arranged between the enlarged shoulder and the bead.

As to claim 2, Capuano discloses the bead being formed as a single piece on the nut body, and is capable of being formed by a pressing process.

Referring to claim 3, Capuano discloses the nut body having a base body 58 and a neckpiece 68 and the turning plate 52 is arranged on the neckpiece.

In regards to claim 4, Capuano discloses a conical surface 140 closing off the neckpiece 68.

As to claim 5, Capuano discloses the bead 100 formed on the neckpiece 68.

Regarding claim 6, Capuano discloses the bead 100 being formed at the transition from the conical surface 140 to the neckpiece 68.

Referring to claim 7, Capuano discloses a notch (the space between neckpiece 68 and turning plate 52) capable of being formed by pressing the conical surface and neckpiece on its edge facing the turning plate.

Regarding claim 8, Capuano discloses the enlarged shoulder 124 having a conical underside 86 at its end facing the neckpiece and the turning plate has a conical surface region 88 along its inner surface that makes contact with the conical underside of the enlarged shoulder.

In regards to claim 9, Capuano discloses the turning plate having a cylindrical surface region 142 along its inner surface which faces the neckpiece.

As to claim 10, Capuano discloses the turning plate having a slightly conical surface region 144 along its inner surface.

Referring to claim 11, Capuano discloses a bevel or chamfer being provided at the end of the cylindrical surface region and slightly conical surface region facing the base body (at 144).

Regarding claim 12, Capuano discloses the turning plate 52 being "somewhat trapezoidal".

As to claim 14, Capuano discloses the nut being a wheel nut for motor vehicles.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 13 and 14/13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capuano (US 4431353) as applied to claims 1-12 above, and further in view of Wilson (US 6102488).

As to claim 13, Capuano discloses the claimed nut except for the base body having a cap. Wilson teaches a cap 56. It would have been obvious at the time the invention was made to a person of ordinary skill in the art to include a cap on the base body of Capuano as disclosed in Wilson for decorative purposes and to more firmly hold the nut and washer together.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited further to show the state of the art with respect to wheel nuts in general: U.S. Pat. No. 2588372 to Erb, U.S. Pat. No. 4971498 to Goforthe, U.S. Pat. No. 5904460 to Kawabata, and U.S. Pat. No. 5042880 to Garuti et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jori R. Schiffman whose telephone number is 703-305-4805. The examiner can normally be reached on M-Th, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on 703-308-1159. The fax phone numbers for the

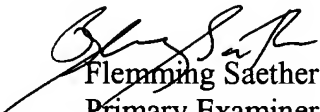
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organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3179.

Jori R. Schiffman
Examiner
Art Unit 3679

JS
May 12, 2003


Flemming Saether
Primary Examiner